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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): HSJ920030072US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 10/23/06

Signature: Kristel Lang

Typed or printed name: Kristel Lang

Application Number	Filed
10/643,265	08/19/2003

First Named Inventor: Toshiki HIRANO

Art Unit	Examiner
2627	Klimowicz, W. J.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 35,398

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

Remarks Accompanying Pre-Appeal Brief Request For Review

In response to the final Office Action dated August 23, 2006, Applicants respectfully request a review of the final rejection in the above identified application. Applicants respectfully submit that the Examiner's rejection of Claims 1, 3, 5 and 7 under 35 U.S.C 103(a) as being unpatentable over Plotto in view of Zhang is improper as an essential element for a proper rejection is missing (e.g., the teaching of all of the recited claim limitations). Applicants also submit that the Examiner's rejection of Claims 2 and 6 under 35 U.S.C. 103(a) is also improper as an essential element for a proper rejection is missing (e.g., the teaching of all of the recited claim limitations). Furthermore, the Examiner's rejection of Claims 4 and 8 under 35 U.S.C. 102(a) as being anticipated by Shimanouchi is also improper as an essential element for a proper prima facie rejection is missing (e.g., the teaching of all of the recited claim limitations).

Rejection of Claims Under 35 U.S.C. 103(a)

KEY CLAIM LIMITATIONS THAT ARE NOT MET BY THE CITED ART

Claim 1 sets forth an airflow shroud for a moving-slider-type microactuator, comprising:

a frame portion having an opening suitable for exposing an air bearing surface of a slider for a disk drive, the frame portion surrounding the slider and a moving-slider-type microactuator coupled to the slider; and

an attachment portion adapted for attachment to a suspension of a disk drive.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (MPEP 2143.03).

In the current Office Action, the Examiner makes reference to Plotto and Zhang in supporting the grounds of rejection. However, Applicants do not understand Plotto alone or in combination with Zhang to teach the claimed feature "an attachment portion adapted for attachment to a suspension of a disk drive." Specifically, the Examiner has cited Column 7, lines 17-21 of Plotto as teaching this claimed limitation.

Applicants disagree that this section of Plotto teaches or even suggests this limitation. In fact, this section of Plotto actually teaches away from this limitation. Specifically, in Column 7, lines 17-21 Plotto teaches "the device PROTECT is fastened by appropriate means, for example by riveting or by welding, to a plate PLAQ secured by means which are not shown to the carriage which carries the said platform. Plotto teaches the shroud attached to a plate which is coupled to the carriage which carries the platform which is different from

attaching to the suspension, as claimed. Zhang fails to remedy the deficiencies of Plotto because, like Plotto, Zhang fails to teach or suggest "an attachment portion adapted for attachment to a suspension of a disk drive," as claimed.

Additional arguments provided on pages 5-7 of the response to the Non-Final Office Action mailed April 18, 2006 are also referenced as evidence that Plotto, alone or in combination with Zhang, does not anticipate the claimed features. For this reason, Applicants respectfully state that the rejection of Claims 1, 3, 5 and 7 under 35 U.S.C. 103(a) is improper and should be reversed.

Applicants also submit that the Examiner's rejection of Claims 2 and 6 under 35 U.S.C. 103(a), is improper because as presented above, Plotto, alone or in combination with Zhang fails to teach or suggest key claim limitations of the present invention. Furthermore, Severson fails to remedy the deficiencies of Plotto and Zhang. In fact, Severson teaches away from the claimed limitations by teaching a shroud that doesn't connect to the suspension, as claimed. For this reason, Applicants respectfully state that the rejection of Claims 2 and 6 under 35 U.S.C. 103(a) is improper and should be reversed.

Rejection of Claims Under 35 U.S.C. 103(a)

According to the Federal Circuit, "[a]nticpation requires the disclosure in a single prior art reference of each claim under

consideration" (W.L. Gore & Assocs. v. Garlock Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983)). However, it is not sufficient that the reference recite all the claimed elements. As stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention "arranged as in the claims" (emphasis added; Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)).

In the current Office Action, the Examiner makes reference to Shimanouchi in supporting the grounds of rejection. However, Applicants do not understand Shimanouchi to teach the claimed feature "an attachment portion adapted for attachment to a suspension of a disk drive." On page 6 of the Office Action mailed August 23, 2006, the Examiner has cited Figure 1 of Shimanouchi as teaching this claimed feature.

Applicants disagree that this section of Shimanouchi anticipates the claimed feature. The Examiner calls the recessed portion in a slider a shroud. Applicants submit that an airflow shroud is very different from a slider. Shimanouchi fails to teach a shroud attached to a suspension, as claimed. For this reason, Applicants respectfully state that Shimanouchi does not anticipate the features of Independent Claims 1, 4, 5 and 8 and as such, the rejection under 35 U.S.C. 102(a) is improper and should be reversed.

In summary, Applicants respectfully submit that the Examiner's rejections of the Claims is improper as key limitations needed for proper prima facie rejections of Applicants' Claims are not met by the cited references as outlined above. Moreover, because key limitations of Independent Claims 1, 4, 5 and 8 (from which claims 2, 3, 6 and 7 depend) are not anticipated by Plotto, alone or in combination with Zhang and Severson. In addition, Key limitations of Independent Claims 1, 4, 5 and 8 (from which claims 2, 3, 6 and 7 depend) are not anticipated by Shimanouchi.

Applicants submit that the rejection of Claims 1, 3, 5 and 7 under 35 U.S.C 103(a) as being unpatentable over Plotto in view of Zhang is improper, Applicants also submit that the Examiner's rejection of Claims 2 and 6 under 35 U.S.C. 103(a) is also improper and furthermore, the Examiner's rejection of Claims 4 and 8 under 35 U.S.C. 102(a) as being anticipated by Shimanouchi is also improper as an essential element for a proper prima facie rejection is missing (e.g., the teaching of all of the recited claim limitations) and should be reversed.